



## Eastern Kentucky University Policy and Regulation Library

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Chapter 2, University Research  
Section 2, Intellectual Property  
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# Intellectual Property

## Statement

The University is committed to creating a culture and infrastructure that nurtures original discovery to advance the well-being of the people of Kentucky and the global community. The Policy set forth herein constitutes an understanding which is binding on ECU Faculty, Staff, Students, and delineated external collaborators as a condition of their participation in ECU research, teaching, and service programs and for their use of ECU funds, facilities, or other resources.

### Purpose

- To make clear the University's values and expectations regarding Intellectual Property (IP);
- To encourage and disseminate research, scholarship, creative activity, and new discovery;
- To provide an infrastructure to guide the University community in bringing new discoveries and developments into use and to evaluate, protect, and manage their commercial significance;
- To provide for the equitable assignment of interests in IP among the author, Innovator, developer, and the University;
- To provide incentives to Innovators in various forms, including, but not limited to, professional development, recognition, and financial compensation;
- To initiate the process of safeguarding IP;
- To provide a transparent process for commercialization opportunities; and
- To enumerate employee-excluded works that are not subject to University ownership under the Policy.

This Policy covers all IP conceived, first reduced to practice, written, or otherwise produced by ECU-associated Faculty, Staff, and/or Students using ECU funds, facilities, or other resources,

including but not limited to, technical expertise. This Policy also covers all Intellectual Property conceived, first reduced to practice, written, or otherwise produced by external collaborators using University resources under a work for hire agreement, if not superseded by other contracts.

## Entities Affected

- Faculty;
- Staff;
- Students; and
- External Collaborators using University resources under a work for hire agreement if not superseded by other contracts.

## Ownership of Copyrights and Inventions

### I. Copyrights

It is the policy of the University that all IP rights in Copyright shall remain with the University. EKU may assign its rights to an external entity sponsoring the development of the IP or assign it back to the Innovator in the following circumstances:

#### A. Works for Hire

Under federal Copyright law, the Innovator of a work is the presumed owner. However, this is not the case when a work is created within the scope of employment, known as “work for hire”. The rule in the Copyright Act pertaining to works for hire gives the University ownership of the Copyrights to works produced by its Employees within the scope of their employment.

#### 1. Instructional Works, Scholarly Works, and Artistic Works

##### a. Faculty

All copyrights in Instructional Works, Scholarly Works, and Artistic Works that are not Works Significantly Derived from University Resources or could be classified as Software and whose Innovators are Faculty remain with their Innovators. The University hereby assigns any of its Copyrights in such works, insofar as they exist, to their Innovators. Such works will not be deemed the University’s IP under this Policy. This practice reflects the University’s commitment to encourage Faculty to write and publish what they wish. In recognition of that longstanding practice, the University disclaims ownership of such works by Faculty, except for Works Significantly Derived from University Resources and Software.

Each Innovator who is a Faculty member grants the University the following licenses with respect to the Instructional Works created during the Innovator's employment at the University:

- i. If the Instructional Works were created with the intention to be used for teaching by the Innovator or others at the University, then the Innovator hereby grants the University a perpetual, nonexclusive, worldwide, royalty-free license to use the Instructional Works for any of the University's teaching and educational purposes as well as for administrative purposes such as accreditation.
- ii. The Innovators also hereby grant the University a nonexclusive, worldwide, royalty-free license to use Instructional Works that were used for the instruction of the University's Students, even if such Instructional Works were not created with the intention to be used for teaching by the innovator or others at the University. Such a license is limited to use for teaching in the same course or in a similar course to that for which the Instructional Works were developed as well as for administrative purposes such as accreditation. The license with respect to such Instructional Works will continue for three years after the Innovator ceases to teach the course in which the Instructional Works were used for the instruction of the University's Students.

The Copyright in all other Copyrighted materials whose Innovators are Faculty which are created within the scope of the Innovators' employment belong to the University.

b. Staff

Any Instructional Works, Scholarly Works, and Artistic Works created by Staff acting within the scope of their employment generally constitutes a work for hire, and the University asserts Copyright ownership in such works. Staff may freely use Instructional Works, Scholarly Works, and Artistic Works developed at the University for educational and/or research purposes but not for commercial purposes.

c. Students

Students who are employed by the University or have created Copyright-eligible materials constituting Works Significantly Derived from University Resources will be treated as Staff per this Policy. Otherwise, Students will retain rights to their Instructional Works, Scholarly Works, and/or Artistic works. For the purposes of this Policy, significant support from Faculty is sufficient to consider Copyright-eligible materials as Works Significantly Derived from University Resources. If a Student's Instructional Works, Scholarly Works, or Artistic Works were created as a result of academic engagement at the University, the University retains a nonexclusive, worldwide, royalty-free license to the Copyrighted works for the duration of the Copyright.

## 2. Software

Subject to federal privacy laws, with respect to all Software, code, and data with commercial value, the University retains all Copyright rights insofar as they exist.

### B. University Commissioned Work

All IP rights in Copyright for works commissioned by the University shall remain with the University.

### C. Work Significantly Derived from University Resources

The Copyright in Works Significantly Derived from University Resources shall be owned by the University. Works Significantly Derived from University Resources are defined as works created using expert University services or created due to extensive use of other University resources that exceeds the level of support that is commonly and customarily accessed by Faculty or Students. The ordinary level of support commonly and customarily accessed may include, for example: the use of desktop computers, the University computer infrastructure, secretarial staff and supplies, or office space and/or the University libraries, and the Copyright in works created using such common and customary resources vests in the Innovator.

### D. Other Contractual Obligations

Notwithstanding any other provision in this Policy to the contrary, nothing in the Policy will be construed to limit the University from entering into specific written agreements with any Faculty, Staff, or Student or with external collaborators, including in connection with sponsored research, that will specify different terms regarding the ownership, distribution, and commercialization of IP. Such an agreement will supersede the terms of this Policy if:

- a. The Innovator is a party to such an agreement; or
- b. The Innovator explicitly or implicitly consented to the terms of such an agreement prior to the creation of the IP.

Without limiting the generality of the foregoing, a decision of an Innovator to develop IP when the Innovator knows, or should know, that such IP is subject to an agreement will be considered consent to that agreement. However, continued employment or affiliation with the University is not, by itself, sufficient to establish consent as required by this section.

Additionally, nothing in the Policy will be construed to limit the University from entering into agreements with respect to the commercialization of University IP. Those agreements would not undermine the University's obligations under this Policy, and in particular, the arrangements set forth in this Policy regarding commercialization.

## II. Inventions

Inventions may include patentable and non-patentable materials. The University shall own all right, title, and interest in any Invention made by (1) any Employee, (2) anyone not meeting the definition of Employee who uses University facilities, equipment, materials or resources, and/or (3) anyone who receives funds provided by or administered by the University. As a condition to each Innovator's employment at the University and/or use of University facilities, equipment, materials, or resources, including funding provided or administered by the University, the Innovator does hereby assign any and all such Inventions to the University.

An Innovator that is a University Employee or Student may own all right, title and interest in certain Inventions. The University hereby assigns to the Innovator(s) every Invention (1) developed by an Employee acting outside of the scope of their employment provided that such IP is not a Work Significantly Derived from University Resources, or (2) developed by a student, provided that the invention was not developed: (a) within the scope of employment of a Student who is an Employee; (b) as part of a sponsored research project; or (c) as part of a course or a University degree program for which the relevant syllabus, made reasonably available to the Students before the invention was developed, provided that the Student will not own such an Invention.

## III. Marks

Use of EKU's name, logo, or Marks must be consistent with the guidelines established in the EKU Visual Identity Guide, promulgated by Communications and Brand Management. Marks affiliated with IP owned by EKU are considered Inventions.

# Procedures

## **Intellectual Property Committee**

The Associate Provost for Research & Economic Development will appoint an ad hoc committee as needed to provide advice on the implementation of this Policy. The committee will be named the Intellectual Property Committee (IPC) and be advisory to the Provost. The IPC will consist of the following members:

- Associate Provost for Research & Economic Development (Chair)
- University Counsel
- Executive Director of CEDET

Other members of the Faculty and Staff, as well as external stakeholders, may be appointed by the IPC Chair as needed in the consideration of IP matters. The IPC is responsible for advising the Associate Provost for Research & Economic Development regarding pursuit of the IP on behalf of the University and for securing appropriate resources for the filing of the patent or other costs associated in protecting the IP.

Responsibilities of this committee may include:

- Review and respond to requests from the Associate Provost for Research & Economic Development on the interpretation of the Policy, and make written recommendations;
- Review and respond to requests from the Associate Provost for Research & Economic Development regarding the ownership of IP;
- Consult with the Provost regarding disputes between innovators and the Office of Research and Economic Development; and
- Review and recommend to the Provost any adjustment of the University's plan for the division of IP revenue, consistent with federal law. Such changes shall not occur without such review.

#### **Completion of the Disclosure Form**

1. When a University Innovator operating under the scope of this Policy creates IP, the Innovator shall notify the Associate Provost for Research & Economic Development by completing the Invention Disclosure Form within a reasonable time of conception or reduction to practice. The disclosure should contain sufficient detail to convey a clear understanding, to the extent known at the time of the disclosure, of the nature, purpose, operation, and technical characteristics of the IP.
2. The completed Invention Disclosure Form must be submitted to the Associate Provost for Research & Economic Development with an informational copy to the appropriate director or dean. In the event the Associate Provost for Research & Economic Development creates IP, the completed Invention Disclosure Form will be submitted to the Provost.
3. A receipt notification will be sent to the Innovator acknowledging receipt of the Invention Disclosure Form within five business days of its receipt, with a copy of this acknowledgement sent to the members of the IPC and the appropriate dean or department head.
4. The Innovator(s) have the responsibility to update the IPC in a timely manner of any developments involving publication, sale, or use of which they become aware after the initial disclosure, and should take all reasonable efforts to make the initial disclosure to the IPC well in advance of any publication, sale, or public use.

#### **Review of the Invention Disclosure Form**

- The IPC shall review IP disclosed to the IPC to suggest the form of IP protection, if any, that should be considered including:

- Copyright: The IPC will review Copyrightable University IP, including Software, disclosed to it. In other instances, the IPC may consult with the Innovator(s) to help ensure that proper notices are affixed to a work and that registration is made in a timely manner.
- Patent and Non-Patentable Material: The IPC will review Invention disclosures and will consult with the Innovator(s) and others as necessary to investigate IP protection routes and commercial potential. The IPC will also assist in determining whether a patent application should be filed.
- Marks: The IPC will review Marks disclosed in the Invention disclosure and will investigate whether the Mark will constitute an Invention, enhancing the commercial value of associated Inventions.
- Working alone or with internal or external collaborators (including the Innovators), the IPC will estimate the potential commercial value for ECU. This process shall include: developing an estimate for the market value for the IP, including consideration of possible IP protections and scope thereof, commercial potential, including market opportunity and competitive landscape, and obligations to sponsors or other third parties.
- The IPC shall have up to 120 calendar days from the disclosure of the IP to assess the scientific, technical, and economic merit as well as determine the potential commercial value. However, the Associate Provost for Research & Economic Development may, in his or her sole discretion, extend the deadline if further examination of the IP is needed or additional information is required. The Innovator(s) shall be given written notice of any such extension, including the reason(s) for the extension, and any extension shall not exceed forty-five (45) days unless mutually agreed upon by the Associate Provost for Research & Economic Development and the Innovator(s).
- The IPC will make a determination as to the appropriate course of action as follows:
  - If the IPC determines that the IP under consideration is exempt under this Policy, or that the chances of successful commercialization are minimal, or the costs of pursuing such commercialization outweigh the income potential, the IP shall be released to the Innovator(s) or appropriate party and ECU will not claim ownership, subject to law and prior agreements. However, ECU shall retain a perpetual, royalty-free, worldwide non-exclusive right to use the IP for educational, research, or service reasons.
  - If the IPC determines that the IP under consideration has not been developed to the point where a decision as to protectability or commercialization is possible, the IPC shall place the creation in a pending status, provide the Innovator(s) with the reasons for taking such action and request that the Innovator(s) report back at a date to be specified by the IPC. The designation of a pending status suspends the 120-day timeframe noted above, and the suspension will be withdrawn when additional, sufficient information is provided to the IPC to allow a decision to be made.
- If the IPC determines that ECU will retain ownership interest in the IP, the IPC will inform the Innovator(s) in writing of a plan for the protection and commercialization of the content(s) of the disclosure.
- The process for licensing, selling, or otherwise conveying IP will comply with any applicable federal or state statutes. All costs associated with these actions shall be borne by ECU, except

that such costs shall be reimbursed to the extent possible and in accordance with the royalty income sharing criteria outlined below if the IP is commercialized.

- If the evaluation of the Disclosure Form has not taken place within one hundred and sixty-five (165) days, or as otherwise agreed to by the Associate Provost for Research & Economic Development and the innovator(s), the University to assigns all rights associated with the specific, disclosed IP retained by the University to the Innovator(s), subject to law and prior agreements.

### **Royalty Income Sharing Criteria**

When two or more individuals have made substantial contributions to IP, Innovators will be treated equally, per federal law. Due to conditions of employment and/or the nature of work assignments, it may be appropriate to agree to alternate distribution of net income for Employees and/or the distribution ratios. Such modifications must be submitted in writing along with the Invention Disclosure Form and will be considered by the IPC. If an agreement cannot be reached, all Innovators will be treated equally, per federal law.

- A. The IP Fund shall be allowed to build across fiscal years. Costs associated with securing IP will be borne by ECU with such costs offset against gross revenues. All costs directly related to the acquisition of IP rights will be reimbursed from the first receipt of revenue, with 75% returned to the IP Fund and 25% to the Innovator until all acquisition costs have been recovered, at which point, distribution is made to the Innovator, department, college, and IP fund as described in Section B. Similarly, future necessary costs for securing IP rights will be reimbursed by revenues prior to distribution (as above).
- B. Except as otherwise provided, net revenues derived from the commercialization of IP shall be shared as follows:
  - 50% to the Innovator
  - 30% to the IP Fund
  - 10% to the Department
  - 10% to the College
- C. The Innovator's rights to share in revenue as stated above (but not including the University's share) shall remain with the individual or pass to the individual's heirs and assigns for so long as net income is derived from the property.
- D. This policy shall not change revenue-sharing agreements entered into prior to the adoption of this Policy.

### **Commercialization of IP**

- The University, through the IPC and the Innovator(s), share responsibility for disclosing Inventions and other licensable IP and cooperating to make the IP available commercially.
- Responsibilities of the Innovator(s) Include:

- Disclosing Inventions, discoveries, and other new IP and updates thereto to the IPC in a thorough and timely manner as stated above.
- Abiding by all commitments made in license, sponsored research, and other agreements and complying with all laws and regulations related to federally and privately funded research.
- Providing such assistance as may be necessary to realize the goals and objectives set forth in this Policy.
- Properly considering, disclosing, and managing any possible conflicts of interest arising from agreements to commercialize IP. If multiple agreements exist, for example, when a company funds University research and has a consulting arrangement with the Innovator(s), there may be conflicts created with respect to IP rights. The Innovator(s) should work with the IPC to resolve such conflicts before beginning work that may create a conflict of interest. University Employees engaged in external consulting work or business, and those charged with approving such activities, are responsible for ensuring that agreements with external entities do not violate or conflict with this Policy or any other University Policy.
- Responsibilities of the University Include:
  - Establishing processes to protect the University's IP rights in order to carry out the University's missions set forth above.
  - Endeavoring to negotiate and manage agreements that are consistent with this Policy.
  - Acting within its broad discretion and in good faith to maximize the value of the IP including, at the University's sole discretion:
    - Publishing or advertising the IP as appropriate;
    - Assisting in finding a partner for the University or a sponsor for the Innovator(s);
    - Providing legal support, through the Office of University Counsel or a third party contracted to provide commercialization support, for all IP activities and initiatives;
    - Preparing legal instruments necessary to realize IP objectives;
    - Providing legal and administrative support following such realization as needed; and
    - Managing conflicts of interest.
- Students who want assistance in the commercialization of their IP may assign their IP to EKV.

### **Resolution of Grievances**

- University constituents (such as Innovators, Innovators' units, Employees, and the IPC) should make every attempt to resolve disputes informally among themselves and, if

needed, with the assistance of other Offices on campus (such as the Office of Academic Affairs, the Faculty Advocate, and/or the Office of University Counsel).

- If any Innovator does not agree with any decision made by the Provost and in the event informal processes and consultation do not provide resolution of a dispute regarding this Policy, an appeal may be made to the President within seven (7) working days of the issuance of the decision. Proceedings will be informal, but all parties will have adequate notice and an opportunity to be heard by the President, or his or her designee.
- The appeal shall be made in writing, delivered to the President and copies shall be made to the Provost and the Associate Provost for Research & Economic Development.
- Any appeal shall set forth the specific reasons supporting the position of the Innovator and include any supporting documentation.
- Within twenty (20) working days from receipt of an appeal of the Provost's decision, the President, or his or her designee, shall review the information provided, determine whether the Innovator has made a reasonable effort to resolve the dispute informally as well as the merits of the dispute, and issue a written decision on the appeal. The decision on this review will be the final decision of the University, subject to external obligations, state, or federal law.

## Definitions

- **Artistic Works:** Works created primarily for their cultural or aesthetic value. Such works may include, but are not limited to, plays, poems, novels, paintings, illustrations, sculptures, and musical compositions.
- **Copyright:** Copyright is the ownership and control of the IP in published and unpublished original works of authorship fixed in a tangible medium of expression. Copyright includes literary, dramatic, and musical Works, such as poetry, novels, movies, and songs, as well as computer software/code and architecture. Copyright does not protect facts, ideas, systems, or methods of operation but could protect the way these things are expressed. Copyright provides the owner with the right to determine how the work is copied, modified, and/or distributed to others (e.g., through sale, lease, or lending).
- **Employee:** Any person employed by the University.
- **Faculty:** All those charged with academic or research instruction and others who have a role in educating, supervising, or advising Students in University programs and disciplines.
- **Instructional Works:** Works created primarily for the instruction of students or for continuing education and certification programs. Such works may include, but are not limited to, slides and presentation content to be used in classes, class notes, exercises and assignments, syllabi, and examinations.
- **Intellectual Property (IP):** Includes tangible or intangible results of research, development, teaching, or other intellectual activity. IP may include the following categories:

1. Inventions, discoveries, or other new developments which are appropriate subjects of patent applications.
2. Copyrightable materials, such as written materials, sound recordings, videos, films, computer programs, computer-assisted instruction materials, works of art including paintings, sculpture, and musical compositions, and all other similar materials, including Artistic Works, Instructional Works, and Scholarly Works.
3. Tangible research property such as biological materials including cell lines, plasmids, hybridomas, monoclonal antibodies, and plant varieties; computer software, data bases, integrated circuit chips, prototype devices and equipment, circuit diagrams, etc.; and analytical procedures, laboratory methods, etc. All such tangible research property may or may not be patentable or copyrightable.

The three categories above are not mutually exclusive; a given article of IP may include aspects of all three categories.

- **Invention:** Any material capable of legal protection and includes any discovery, process, know-how, trade secret, design, model, computer algorithms/Software (if patentable), strain, variety, or culture of an organism, or portion, modification, translation, or extension of these items. It includes Marks used in connection with these. It also includes Tangible Research Property.
- **Inventor:** A member of the Eastern Kentucky University community who engaged in the conception or subsequent derivations of Intellectual Property.
- **Mark:** trademarks, service marks, collective marks, and certification marks.
- **Scholarly Works:** Scholarly Works means all Copyrightable works authored by Faculty within the scope of their employment. Common examples of Scholarly Works include, but are not limited to, journal articles, scholarly papers, books (e.g., monographs, textbooks, and other books), and case examples, regardless of the medium in which those works are fixed or disseminated.
- **Software:** The source code and/or object code of computer applications and subroutine libraries. Software, for the purposes of this Policy, does not include Artistic Works in the form of computer-generated works of art or music or the content of other forms of works, such as traditional Scholarly Works, that are recorded in a Software medium.
- **Staff:** All Employees of the University who are not otherwise considered Faculty.
- **Students:** All those enrolled full-time or part-time in any course, program of study, or discipline, or who are performing research under an exchange program or with EKU funding.
- **Tangible Research Property:** Includes, but is not limited to, materials, computer software, computer databases, prototype devices or equipment, engineering designs or drawings, integrated computer chips, audiovisual works, antibodies, genetically modified animals, and cell lines. Items of tangible research property may be associated with one or more intangible properties such as patents, Copyrights, and trademarks.

- **University:** Eastern Kentucky University (EKU)
- **Works Significantly Derived from University Resources:** Works created using expert University services or extensive use of other University resources that exceeds the level of support that is commonly and customarily accessed by Faculty or Students.

**Interpreting Authority**

University Counsel

**Policy Adoption Review and Approval**

**Policy Revision**

<u>Date</u>	<u>Entity</u>	<u>Action</u>
June 19, 2017	Board of Regents	Adopted
May 24, 2017	President	Approved
May 3, 2017	Provost Council	Approved
May 1, 2017	Faculty Senate	Approved
January 21, 2005	Board of Regents	Adopted
November 1, 2004	Faculty Senate	Approved

**Policy Issued (as Patent and Copyright Policy)**

<u>Date</u>	<u>Entity</u>	<u>Action</u>
January 21, 1989	Board of Regents	Adopted
February 1, 1988	Faculty Senate	Approved